

08 SEP 2006



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In re Application of
CARTER et al.
Application No.: 10/518,813
PCT No.: PCT/AU03/00827
Int. Filing Date: 27 June 2003
Priority Date: 28 June 2002
Attorney Docket No.: COCH-0132-US1
For: MEDICAL DEVICE TESTING
APPARATUS

DECISION ON REQUEST

UNDER 37 CFR 1.497(d)

This is a decision on applicants' "Response to Notification of Defective Response", treated as a petition to correct inventorship under 37 CFR 1.497(d), and filed on 08 May 2006 in the United States Patent and Trademark Office (USPTO). Petitioner seeks to add David J. Bull as inventor in the above referenced application. The requisite \$130 petition fee was paid. Petitioner also requests a three month extension of time, which is granted.

BACKGROUND

On 22 December 2004, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371 with, *inter alia*, the requisite basic national fee.

On 27 October 2005, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) & (b), and the surcharge for filing the oath or declaration after the thirty month period, was required.

On 27 December 2005, applicant filed a response to the Notification of Missing Requirements. The declaration submitted identified David J. Bull as an inventor; however, the published international application did not identify him as such.

On 24 January 2006, a Notification of Defective Response was mailed to applicant indicating that the declaration was not executed in compliance with 37 CFR 1.66 or 1.68; that is, inventor David John Bull is not listed on the published international application. Applicant was given one month within which to respond or the time period remaining in the Notification of Missing Requirements.

On 08 May 2006, applicant filed a petition for correction of inventorship, to add David J. Bull as an inventor. In addition to the \$130 petition fee, Petitioner provided the statement of the inventor Mr. Bull in support of the correction of inventorship under 37 CFR 1.497(d). A declaration executed by the joint inventors was provided along with an Application Data Sheet.

DISCUSSION

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person

being added as an inventor that any error in inventorship occurred without deceptive intention on his or her part; (2) the fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee(s).¹

Applicants provided a statement, signed by David J. Bull, stating that "any error in inventorship in the international application, PCT/AU2003/00827, filed on June 27, 2003, occurred without deceptive intention on my part." This statement satisfies item (1) of 37 CFR 1.497(d).

The processing fee of \$130.00 has been paid, satisfying Item (2) above.

With regard to Item (3), the written consent of the assignee, Cochlear Limited, consenting to the addition of David J. Bull as an inventor in this application was submitted. Item (3) above is satisfied.

Accordingly, applicant has met all of the requirements to add David J. Bull as co-inventor in the above-identified international application.

CONCLUSION

For the reasons discussed above, the submission under 37 CFR 1.497(d) to add David J. Bull as an inventor is hereby **GRANTED**.

The application will be forwarded to the United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1), (2) and (4) date is **08 May 2006**.



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¹37 CFR 1.497(d) states, in part: If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor . . . that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(I); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees.